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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91125615
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

University of Southern California)	Opposition No. 91125615
)	
Opposer,)	Serial No. 75/358,031
)	
vs.)	Mark: SC (Stylized)
)	
University of South Carolina,)	Filed: September 16, 1997
)	
Applicant.)	Published: May 18, 1999
)	

RESPONSE TO OPPOSER'S SEPARATE STATEMENT OF OBJECTIONS

Applicant, the University of South Carolina hereby submits its Response to Opposer's
Separate Statement of Objections.

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INTRODUCTION

At the outset, Applicant the University of South Carolina (“Applicant” or “South Carolina”) would state its position that Opposer the University of Southern California’s (“Opposer” or “California”) has submitted an excessive amount of objections in this matter. Essentially, Opposer has used its forty-one (41) pages of objections as a *de facto* forum to make arguments regarding the merits of the case in chief. Parties to litigation rarely agree on the relative weight and credibility which should be afforded one another’s offers of proof. However, that determination is ultimately to be made by the fact finder.

Throughout its objections, Opposer confuses the issue of credibility and weight of evidence with the threshold issue of admissibility. Therefore, to the extent that Opposer has engaged in generalized arguments regarding the persuasiveness of Applicant’s evidence, as opposed to the proper question of whether such evidence is admissible under the Federal Rules of Evidence, Applicant asserts that such arguments are improper and should be disregarded. Nevertheless, in order to protect the record, Applicant is forced to address each of Opposer’s specific points.

I. APPLICANT’S RESPONSE TO EVIDENTIARY OBJECTIONS TO TRIAL TESTIMONY ELICITED FROM SOUTH CAROLINA’S WITNESSES

A. Applicant’s Response to Objections to Testimony Deposition of Elizabeth West (“TD-West”)

1. TD-West 5:23-6:8, 6:23-7:15, 22:4-17, 46:9-11, 47:6-50:9

Opposer has raised several objections to Ms. West’s testimony regarding historical use by South Carolina of the letters “SC.” South Carolina responds to each of these objections as follows:

Best Evidence/Documents Speak for Themselves- Opposer's best evidence objection is misplaced where, as here, the documents which are the subject of the testimony have actually been produced to the Board.

Specifically, commentators have noted that "[t]he only actual rule that the 'best evidence' phrase denotes today is the rule requiring the production of an original writing, recording, or photograph." 2 McCormick On Evid. § 231 (6th ed.) In this situation, the documents about which Ms. West is testifying have been authenticated without objection and moved into evidence by the Applicant. Therefore, there can be no violation of the "Best Evidence Rule" by her testimony, as there is no dispute with regard to the location of the original documents.

Moreover, Opposer's objection based on the idea that the "documents speak for themselves" is also misplaced. As the Board will see from the exhibits which have been moved into evidence by Applicant, there are several which require explanation and context to ensure that an observer can derive the significance of each. Ms. West's testimony simply provides such context for the Board. Therefore, Opposer's objection that the "documents speak for themselves" should be overruled. See e.g. United States v. Cooper, 375 F.3d 1041 (10th Cir. 2004) (district court's ruling that documents required explanation and therefore did not "speak for themselves" upheld).

Hearsay- To begin, the Opposer makes a hearsay objection, but nowhere in this testimony does Ms. West testify about a third party's description of the use of any form of the "SC" Mark. The material cited by Opposer within the West trial deposition is not hearsay. Hearsay is an out-of-court statement being offered for the truth of the matter asserted. See Fed. R. Evid. 801(c). Here, Ms. West testified as a fact witness as to her observations gained during the course of her duties as university archivist. Such observations regarding the various uses of

the letters “SC” are therefore not hearsay. In fact, a review of the cited testimony demonstrates that there are no out-of-court “statements” being offered at all which would fall under the category of hearsay. As such, Opposer’s objection on the grounds of hearsay is misplaced.

Improper Expert Opinion- As earlier stated, in her capacity as university archivist, Ms. West is testifying as a fact witness as to her observations in the course of her duties. Therefore, to the extent her testimony is factual in nature, it cannot be considered expert testimony. Moreover, the material to which Ms. West testified was within her personal knowledge and she was not asked to give expert opinions on any complicated or technical subject matters. Therefore, among other things, her testimony is admissible under Fed. R. Evid. 701 and this objection by Opposer is unfounded. See e.g., Mattison v. Dallas Carrier Corp., 947 F.2d 95 (4th Cir. 1991) (lay fact witness may testify in the form of opinion if the opinion is rationally based on the perception of the witness and helpful in understanding his testimony or in determining a fact in issue).

2. TD-West 9:6-18, 11:10-12:6, 13:5-10, 14:3-8, 15:6-14, 16:9-17, 17:9-19, 18:11-16, 19:8-13, 45:9-13

Opposer has raised several objections to Ms. West’s testimony discussing and explaining the nature and contents of documents contained in the record. South Carolina responds to each of these objections as follows:

Best Evidence/Documents Speak for Themselves- Opposer has made another objection to this second set of excerpted testimony on the grounds of “Best Evidence/Documents Speak for Themselves.” In addition to the arguments in response already set forth above, Applicant would simply highlight the fact that, as one Court has noted:

“The truism that ‘documents speak for themselves’ is not without qualification. The photocopies of the sales brochures require some further explication. Not being an authority in the areas of office supplies and business data machinery, this

court declines to rest any ultimate determinations as to the likelihood of confusion upon the sales brochures as they are currently submitted by plaintiff.”

National Blank Book Co. v. National Data Products, Inc., 213 U.S.P.Q. 70, *13 (N.D. Ind. 1981) (party admonished for failing to adequately explain contents of sales brochures).

Similarly here, the cited testimony to which Opposer objects deals with photographs and documents intertwined with the history of both the University and State of South Carolina. Assuming that these are not matters which are peculiarly within the knowledge of the Board members, Ms. West’s testimony is provided simply to illuminate the surrounding circumstances of these materials. Therefore, Opposer’s objections on these grounds are unfounded.

Lack of Foundation/No Competence- Despite Opposer’s contention to the contrary, Ms. West is both competent and qualified to testify on the matters contained within the cited testimony. Ms. West is the University Archivist for South Carolina and is in charge of acquiring, caring for and making accessible historical documents and records of the University of South Carolina. See e.g. TD-West 4:14–5:7, 19:21–22:3. Ms. West spent hours researching and reviewing the records in the University Archives and South Carolina Department of Archives and History to educate herself on the use of the letters “SC” by the State of South Carolina and the University of South Carolina TD-West 19:21-22:3. Among other records that she reviewed were yearbook photographs, yearbook publications and other materials created by South Carolina. Id. Therefore, Ms. West had the proper knowledge and foundation. These objections should be overruled.

B. Applicant's Response to Objections to Testimony Deposition of Kenneth Corbett ("TD-Corbett")

1. TD-Corbett 43:3-55:5

Opposer has raised several objections to Mr. Corbett's testimony regarding documents relating to other educational institutions. South Carolina responds to each of these objections as follows:

Best Evidence/Documents Speak for Themselves- As cited above, because these documents about which Corbett testifies have been authenticated, the Best Evidence Rule is not an issue. Further, the substance of the cited testimony is comprised of Corbett authenticating these documents and identifying the various uses of "SC" in each of the exhibits. Therefore, Corbett's testimony merely highlights the significance of each exhibit, which is not necessarily obvious on the face of the materials. As such, the documents do not truly speak for themselves. National Blank Book Co., 213 U.S.P.Q. 70.

Irrelevant- It is impossible to determine how Opposer can conceivably claim that this testimony relating to third party uses of the "SC" mark by other educational institutions is irrelevant. On the contrary, it is directly relevant to Applicant's position that Opposer has failed to police its "SC" mark and further that the use of "SC" by multiple third parties demonstrates (a) that there is no likelihood of confusion and (b) that Opposer's mark is relatively weak.

Evidence of widespread third-party use, in a particular field, of marks containing a certain shared term is competent to suggest that purchasers have been conditioned to look to the other elements of the marks as a means of distinguishing the source of goods or services in the field. In re: Broadway Chicken, Inc., 38 U.S.P.Q.2d 1559, 1565-66 (T.T.A.B. 1996); In re: Bed & Breakfast Registry, 791 F.2d 157, 229 U.S.P.Q. 818, 819 (Fed. Cir. 1986) ("The record shows that a large number of marks embodying the words 'bed and breakfast' are used for similar

reservation services, a factor that weighs in favor of the conclusion that BED & BREAKFAST REGISTRY and BED & BREAKFAST INTERNATIONAL are not rendered confusingly similar merely because they share the words ‘bed and breakfast’’).

California attempts to substantively argue that this evidence does not show that any use of the letters “SC” were made by these universities. However, the use as shown by the exhibits and described by Mr. Corbett establish use of the letters “SC” as a service mark for education services and entertainment services in the nature of live exhibition of sporting events. Moreover, Opposer’s speculation concerning the scope of use of the letters “SC” by these universities is improper and unsupported by any evidence in the record. As such, the cited testimony is directly relevant and Opposer’s objection should be overruled.

2. TD-Corbett 39:20-40:16

Opposer has raised several objections to Mr. Corbett’s testimony regarding purchasers of Applicant’s products. South Carolina responds to each of these objections as follows:

Lack of Foundation/Competence- As an initial matter, Corbett is a fact witness and these matters are within his knowledge and are admissible. As his testimony demonstrates, he is particularly qualified to testify regarding purchasers of collegiate merchandise bearing Applicant’s marks. See TD-Corbett 4:22-10:3. Among other things, since 1994, Mr. Corbett has been involved in licensing at South Carolina. TD-Corbett 6:12-7:5. As the licensing director, Mr. Corbett is in charge of license review, product approval and trademark policing. TD-Corbett 8:1-9:4. Mr. Corbett is familiar with the retail market for South Carolina products and makes regular monthly visits to “see what is going on in the marketplace.” Id.

Moreover, even if his testimony can be considered “opinion”, it is nevertheless admissible. See e.g., Mattison, 947 F.2d 95 (lay fact witness may testify in the form of opinion if

the opinion is rationally based on the perception of the witness and helpful in understanding his testimony or in determining a fact in issue). Interestingly, the court in New Colt Holding Corp. v. RJG Holdings of Fla., Inc., 2003 U.S. Dist. LEXIS 25309, **7-9 (D. Conn. 2003) was faced with a similar issue, although the proffering party was instead attempting to use expert testimony to "establish the nature of the markets and consumers, . . . the behavior and knowledge of consumers in those markets, the conduct of such consumers during such purchases, the lack of any confusion in the actual market, and the fact that no one would substitute the Defendants' products for the [Plaintiff's products]." In denying the defendant's proffer of such expert testimony, the court stated that this testimony should be accomplished through fact witnesses:

and does not appear to involve the sort of 'specialized knowledge' that would be incomprehensible absent expert opinions. If opinion testimony is required, it is not apparent why such testimony could not be offered through lay opinion. See United States v. Figueroa-Lopez, 125 F.3d 1241, 1246 (9th Cir. 1997) ("lay witness testimony is governed by Rule 701, which limits opinions to those 'rationally based on the perception of the witness.' Rule 702, on the other hand, governs admission of expert opinion testimony concerning 'specialized knowledge.'"); Certain Underwriters at Lloyd's, London v. Sinkovich, 232 F.3d 200, 203 (4th Cir. 2000) (noting that "critical distinction between Rule 701 and Rule 702 testimony is that an expert witness must possess some specialized knowledge or skill or education that is not in the possession of the jurors" (internal quotation marks omitted)). Testimony from experts may be used to assist the trier of fact in understanding complex subject matter, see, e.g., First Tenn. Bank Nat'l Ass'n v. Barreto, 268 F.3d 319 (6th Cir. 2001) (addressing lender-borrower relationship in banking industry), whereas lay testimony may serve the purposes for which defendants now propose requires expert testimony. Newport Elecs. v. Newport Corp., 157 F. Supp. 2d. 202, 208-09 (D. Conn. 2001) (permitting lay opinion testimony from president of company on products sold by company, his understanding of what was sold and what competitor sold and actual confusion that he and his company had experienced). It is thus not apparent how the proposed testimony is beyond the understanding of a jury, thus requiring the use of experts.

New Colt Holding Corp., 2003 U.S. Dist. LEXIS 25309 at ** 7-9 (D. Conn. 2003).

Finally, Opposer has sought to introduce nearly identical evidence relating to consumers as that which it challenges here. Therefore, to the extent that any of this testimony is stricken,

Applicant requests that all of Opposer's offered testimony regarding characteristics of purchasers also be stricken from the record.

Hearsay- There is no evidence (and Opposer failed to provide any) to suggest that Corbett's testimony is primarily based upon conversations with third parties. Rather, his testimony demonstrates that his knowledge arises from his observations in his capacity with South Carolina. Therefore, without more evidence, Opposer's hearsay objection is unfounded and should be overruled.

3. TD-Corbett 90:9-23

Opposer has raised several objections to Mr. Corbett's testimony regarding the lack of confusion between Applicant and Opposer's products. South Carolina responds to each of these objections as follows:

Lack of Foundation/Irrelevant- Opposer again attempts to attack Corbett's knowledge regarding any confusion between Applicant and Opposer's products, or, more specifically, the lack thereof. As already stated, Corbett is particularly qualified to testify regarding the sale of Applicant's products (See TD-Corbett 4:22-10:3), and his knowledge of a lack of confusion with Opposer's products is both relevant and admissible, despite Opposer's objection. See New Colt Holding Corp., 2003 U.S. Dist. LEXIS 25309 at ** 7-9 (D. Conn. 2003).

Improper Redirect- As Opposer admits, its cross-examination of Corbett related to colors of hats bearing Applicant's marks as well as the use of any secondary identifiers on products. (See Opposer's Objections, p. 5.) Contrary to Opposer's assertion, these subjects relate directly to the existence of confusion between Applicant and Opposer's products. Specifically, one of the disputed issues in this case includes whether various colors and secondary identifiers

on goods make consumer confusion more or less likely. Applicant's re-direct examination of Corbett on this topic was, therefore, entirely permissible.

C. Applicant's Response to Objections to Testimony Deposition of C. "Kit" Walsh ("TD-Walsh")

1. TD-Walsh 24:8-28:16, 90:11-91:4

Opposer has raised several objections to Mr. Walsh's testimony regarding retail consumers of products bearing Applicant's marks. South Carolina responds to each of these objections as follows:

Lack of Foundation/Speculation/Improper Expert Opinion- Each of these objections essentially relates to Walsh's qualification and abilities to testify regarding the qualities of retail consumers. California argues that, to the extent that Mr. Walsh is testifying concerning consumers' mindset, such testimony is speculation. This position is simply incorrect. See e.g., Coca-Cola Co v. Overland, Inc., 692 F.2d 1250, 216 U.S.P.Q. 579 (9th Cir. 1982) (affirming judgment in favor of Coca-Cola based on testimony of waitstaff concerning what customers were thinking when they ordered "Coke.") Lay witness testimony, such as Mr. Walsh's, is admissible so long as it would be helpful to the fact finder and is rationally based on personal perception. Scheerer v. Hardees's Food Sys., 148 F.3d 1036 (8th Cir. 1998).

Mr. Walsh's personal experience allowed him to rationally come to the conclusions that were elicited. In his job with Collegiate Licensing Company ("CLC"), Walsh has specific and detailed knowledge regarding the purchase of goods bearing Applicant's marks. See TD-Walsh 5:22-12:24. Further, as a CLC representative for multiple other schools, Walsh has knowledge of the marketplace which is at issue in this case. Id. Moreover, Mr. Walsh, who is the Senior Vice President for Marketing at the CLC, testified that CLC is the largest licensing and marketing agent in the field of university and inter-collegiate athletics and, as the Senior Vice-

President for Marketing, that he oversees and manages the entire licensing process between universities and product manufacturers and ensures that CLC works with licensors and retailers “in the retail marketplace in an attempt to grow the business for collegiate-licensed products in the marketplace.” TD-Walsh 11:16-12:1. Therefore, Walsh is qualified to testify on these matters, and a proper foundation for his testimony is present, and Opposer’s objection on these grounds should be overruled.

Moreover, this is the same type of evidence Opposer sought to introduce through its witnesses, and such witnesses were less qualified than Walsh. Therefore, to the extent that any part of Opposer’s objection on this issue is sustained, Applicant requests that all of Opposer’s testimony of the issue of retail consumers be stricken as well.

Calls for an improper legal conclusion- There is no evidence or suggestion that “level of care” as it was used in this context was either a technical term or a term of art. Applicant is not offering Walsh’s testimony on this point as a “legal conclusion” and therefore, Opposer’s objection is unfounded.

Leading- The question immediately preceding the allegedly leading question established (without objection) that South Carolina’s baseball team used the logo in Applicant’s Exhibit 3. See TD Walsh 90:19-22. Therefore, the question to which Opposer is objecting is not leading since Walsh had just testified that South Carolina’s baseball team used the logo. As such, Opposer’s objection should be overruled.

2. TD-Walsh 31:11-18

Opposer has raised several objections to Mr. Walsh’s testimony regarding the absence of a likelihood of confusion among consumers. South Carolina responds to each of these objections as follows:

Lack of Foundation/Speculation/Improper Expert Opinion- Again, these objections are aimed at Walsh's alleged lack of qualifications. In light of Walsh's qualifications, discussed above (TD-Walsh 5:22-12:24), and his knowledge of the marketplace, he was qualified to testify regarding the lack of confusion among consumers of products licensed by educational institutions. This is especially true when one considers that Walsh represents multiple different universities in his capacity as a university representative with CLC. (TD-Walsh 7:3-18.) Finally, the absence of notification as to a particular subject (*i.e.* the existence of marketplace confusion) relates to the weight, not the admissibility, of evidence.

Calls for an improper legal conclusion- This questioning did not request a legal conclusion. Based upon his knowledge of the relevant goods and consumer base, Walsh could testify as to whether confusion was likely among buyers. Therefore, this objection should be overruled.

3. TD-Walsh 20:9-21:2

Opposer has raised an objection to Mr. Walsh's testimony regarding Internet back-end fulfillment. South Carolina responds to this objection as follows:

Lack of Foundation- The basis for this testimony rests in Walsh's qualifications (TD-Walsh 5:22-12:24) as well as the questions related to internet sales and marketing which led up to the cited testimony. (See TD-Walsh 19:19-20:8.) Opposer cannot challenge that Mr. Walsh is obviously knowledgeable about Internet retailing of collegiate merchandise. Mr. Walsh established that his job duties include working with retailers "in the retail marketplace in an attempt to grow the business for collegiate-licensed products in the marketplace." (TD-Walsh 11:16-12:1.) The retail market place includes online retail sales. (TD-Walsh 19:22-20:16.) Therefore, this objection should be overruled.

4. TD-Walsh 31:20-32:18

Opposer has raised several objections to Mr. Walsh's testimony regarding the purported overlapping of goods bearing Applicant's and Opposer's marks. South Carolina responds to these objections as follows:

Vague and Ambiguous- The questions and responses in the cited testimony are not vague and ambiguous. The testimony generally refers to the purported overlap between Applicant's mark and Opposer's "SC" Athletic Interlock mark and Baseball Interlock mark. The fact that Walsh testified *generally* regarding product overlap (or lack thereof) does not render the testimony vague or ambiguous.

Lack of Foundation- The basis for the cited testimony rests in Walsh's qualifications (TD-Walsh 5:22-12:24) as well as the questions related to the purported overlapping of goods which led to the cited testimony. (TD-Walsh 30:14-31:19.) Therefore, this objection should be overruled.

5. TD-Walsh 35:11-36:8, 37:8-13

Opposer has raised an objection to Mr. Walsh's testimony regarding the sale of goods by Belk, Dillard's, and Kohl's Department Stores. South Carolina responds to this objection as follows:

Lack of Foundation- The basis and foundation for this testimony rests in Walsh's qualifications. (See TD-Walsh 5:22-12:24.) Certainly, based upon his qualifications, Walsh possesses knowledge of the sale of university licensed products to and by department stores. This subject does not require any specialized or particular knowledge, and the questions asked of Walsh were not technical in nature. Therefore, this objection should be overruled.

6. TD-Walsh 40:16-46:6

Opposer has raised an objection to Mr. Walsh's testimony regarding hats from various schools around the country. South Carolina responds to this objection as follows:

Irrelevant- Opposer attempts to claim that the coexistence of multiple other universities in similar, if not identical, situations to the present case has no bearing on this proceeding. This is patently false. Evidence of widespread third-party use, in a particular field, of marks containing a certain shared term is competent to suggest that purchasers have been conditioned to examine college athletic marks closely as a means of distinguishing the source of goods or services in the field. In re: Broadway Chicken, Inc., 38 U.S.P.Q.2d 1559, 1565-66 (T.T.A.B. 1996) (third party evidence that "a certain shared term is competent to suggest that purchasers have been conditioned to look to the other elements of the marks as a means of distinguishing the source of goods or services in the field"). The fact that multiple other universities (in the common field of providing both educational services and exhibitions of athletic events) have utilized marks containing certain shared terms strongly suggests that the consumers in this field look to other elements (*i.e.* differences in fonts, designs, colors, mascots, etc.) to distinguish the source of the goods.

In support of its position California cites Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Mainson Fondée En 1772, 396 F.3d 1369, 1373, 73 U.S.P.Q.2d 1689, 1693 (Fed. Cir. 2005). In this case, Palm Bay submitted evidence of 5 other uses of the term "Veuve". The Board rejected the evidence because the catalog submitted did not show that customers were exposed to these marks. However, South Carolina was not offering Mr. Walsh's testimony concerning the strength or weakness of California's marks. The testimony of Mr. Walsh was used to demonstrate and establish the other elements that consumers look at in the field of

collegiate merchandise. With respect to the hats shown to Mr. Walsh, these hats were identified as true and accurate specimens of what was available in retail stores. Based upon the foregoing, this evidence is directly relevant to the issues in the present proceeding and Opposer's objection should be overruled.

7. TD-Walsh 88:25-90:2

Opposer has raised objections to Mr. Walsh's testimony regarding the lack of confusion with regard to caps bearing Applicant's and Opposer's marks. South Carolina responds to this objection as follows:

Lack of foundation- California misleads the Board by alleging that Mr. Walsh is "several steps removed from the retail customer." The complete opposite is, in fact, the truth: Throughout his career, Mr. Walsh has been extensively involved in retail and customer issues in the collegiate product field. As a university representative, from 1993 to 1997, his job duties included "retail marketing issues", including, determining "whether there was an opportunity to do more with retailers and convince them to carry product." (TD-Walsh 6:15-24.) This necessarily entails a knowledge of consumer demands and preferences. After 1997, he took on an additional role at CLC in the field of "apparel marketing." (TD-Walsh 7:20-8:12.) After this he transitioned to working to the role of a "retail services position." (TD-Walsh 8:15-24.) This involved "cultivating relationships with the retailers and the retail buyer's decision makers at those different retailers of college product." Id. As the Senior Vice-President for Marketing, Mr. Walsh now spends most of his time focusing on collegiate products "in the retail marketplace in an attempt to grow the business for collegiate-licensed products in the marketplace." (TD-Walsh11:16-12:1.)

Walsh testified he was unaware of confusion. It is difficult to determine how the absence of notification regarding a particular issue requires a foundation. However, it is clear that Walsh had the necessary background knowledge and would have been aware of any confusion should it have existed. Here, Walsh was asked if he was aware of widespread confusion among various marks and he answered in the negative. Opposer can argue over the lack of weight which should be granted to this testimony but (as Opposer has done throughout these objections) it confuses the questions of persuasiveness with the threshold question of admissibility. Clearly this testimony is admissible.

Irrelevant- For the reasons repeatedly cited above, the evidence of third-party uses of trademarks is relevant to the present proceeding as it strongly suggests that, within the specialized field of university licensing and marketing, there is no widespread confusion among consumers of such merchandise. Therefore, Opposer's objection on this issue should be overruled.

II. APPLICANT'S RESPONSE TO EVIDENTIARY OBJECTIONS TO EXHIBITS ATTACHED TO APPLICANT'S TESTIMONY DEPOSITIONS

South Carolina hereby responds to California's objections to exhibits attached to applicant's testimony depositions.

A. Exhibit 13 to the Testimony Deposition of C. "Kit" Walsh Taken March 1, 2006

Opposer has objected to Applicant's Exhibit 13 to the Testimony Deposition of Kit Walsh on the grounds that the Exhibit is not relevant to any issue in the proceeding. However, Applicant contends that the use and coexistence of similar marks by different universities demonstrates that lack of a likelihood of confusion between Applicant and Opposer's marks.

Exhibit 13 depicts hats bearing various third-party university logos which contain identical letters to one another. In his deposition, Walsh testified that, although many of the hats

depicted in Exhibit 13 shared the same letters, he was able to differentiate each and identify the source or university represented by each hat based upon the stylized version of the letters on the hat, other logos used on the hat, and/or the colors used on the hat. (TD-Walsh 40:16 – 46:11.)

The fact that dozens of universities use identical abbreviations to refer to themselves and then place these letters on hats with no widespread evidence of confusion tends to support Applicant's position that no confusion can or will exist between goods bearing Applicant's and Opposer's marks.

California's objections are misplaced. They are based upon a straw man assumption that South Carolina offered the various hats to prove the strength of the letters "SC". In support of its position California cites Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Mainson Fondee En 1772, 396 F.3d 1369, 1373, 73 U.S.P.Q.2d 1689, 1693 (Fed. Cir. 2005). In this case, Palm Bay submitted evidence of 5 other uses of the term "Veuve" in order to attack the strength of that mark. Id.

South Carolina offered this evidence to illustrate that conditions surrounding sales of collegiate merchandise are such that consumers exercise a heightened analysis of the marks and products so that confusion is avoided. Evidence of widespread third-party use, in a particular field, of marks containing a certain shared term is competent to suggest that purchasers have been conditioned to examine college athletic marks closely as a means of distinguishing the source of goods or services in the field. In re: Broadway Chicken, Inc., 38 U.S.P.Q.2d 1559, 1565-66 (T.T.A.B. 1996) (third party evidence that "a certain shared term is competent to suggest that purchasers have been conditioned to look to the other elements of the marks as a means of distinguishing the source of goods or services in the field"). The fact that multiple other universities (in the common field of providing both educational services and exhibitions of

athletic events) have utilized marks containing certain shared initials strongly suggests that the consumers in this field look to other elements (*i.e.* differences in fonts, designs, colors, mascots, etc.) to distinguish the source of the goods. As such, this evidence is not being offered to discuss the strength of the letters contained on the hat. Therefore, Exhibit 13 is relevant to Applicant's case and it should be admitted.

B. Exhibit 51 to the Testimony Deposition of Kenneth Corbett Taken March 3, 2006

Opposer has objected to Applicant's Exhibit 51 to the Testimony Deposition of Ken Corbett on the grounds of hearsay. Exhibit 51 is Applicant's application to the Trademark Commission. Applicant is not relying on the affidavit of Thomas Stepp for the truth of the matter asserted therein which could trigger the hearsay rule (although all of the statements in Stepp's affidavit are true). Rather, Applicant has submitted Exhibit 51 as evidence of its application to the Trademark Commission. Therefore, Opposer's objection based upon hearsay is unfounded.

C. Exhibits 70 and 71 to the Testimony Deposition of Kenneth Corbett Taken March 3, 2006

Opposer has objected to Applicant's Exhibits 70 and 71 to the Testimony Deposition of Ken Corbett, although there is no discernable basis for the objection. These exhibits are printouts from various apparel and merchandise websites which sell goods bearing Applicant's mark. Opposer objects to these exhibits on the muddled basis that "[w]hile Applicant contends that Applicant's Exhibits 70-71 demonstrate that there are no instances of actual confusion, Applicant's evidence only shows that some of the websites have been corrected." (Opposer's Objections, p.12.) Frankly, this is neither a valid (nor easily identifiable) basis for exclusion. Both parties have submitted website printouts on the issue of likelihood of confusion and, in this instance, the website printouts demonstrate that there was no commingling of Applicant's and

Opposer's goods by these merchants at the time they were printed out. This supports Applicant's position that there is no likelihood of confusion as the goods are sold, thus Exhibits 70 and 71 are relevant and should not be excluded.

D. Exhibits 72-87 to the Testimony Deposition of Kenneth Corbett Taken March 3, 2006

Opposer has objected to Applicant's Exhibits 72-87 on the basis that these exhibits are not relevant. Each of these exhibits is a website printout of third-party colleges and universities utilizing the "SC" mark. Somehow, Opposer contends that such widespread use by third-parties is not relevant. Contrary to Opposer's position, whether a mark is classified as "strong" or "weak" is a very important element in deciding likelihood of confusion. 3 McCarthy on Trademarks and Unfair Competition (3rd ed.) § 23.15[6]. A portion of a mark may be weak if that portion is in common use by other sellers. Id.

Likewise, use of the mark by multiple third parties suggests that Opposer should not now be allowed to "pick and choose" who gets to make use of the "SC" word mark. Swedish Beer Export Co. v. Canada Dry Corp., 469 F.2d 1096, 176 U.S.P.Q. 59 (C.C.P.A. 1972) (agreement that the beer manufacturer made with a vodka distributor over the concurrent use of "SKOL" as a name for beer and vodka precluded a finding of a "likelihood of confusion" against a soft drink manufacturer utilizing a similar mark). As such, the widespread use of the "SC" mark by other educational institutions is entirely relevant to these proceedings and these exhibits should therefore be allowed.

California attempts to substantively argue that this evidence does not show that any use of the letters "SC" were made by these universities with respect to products. However, the exhibits establish use of the letters "SC" as a service mark for education services and entertainment services in the nature of live exhibition of sporting events. This is all that must be

shown to establish relevance. California's trademark rights are not based upon its goodwill or fame as a manufacturer of clothing or headwear. On the contrary, the "SC" used by California on its goods is merely ornamental and would not be registrable but for the letters "SC" serving as a secondary indicator of source. In re Olin Corp., 181 U.S.P.Q. 182, 183 (T.T.A.B. 1973) ("It is a matter of common knowledge that T-shirts are "ornamented" with various insignia, including college insignias . . . [such] 'ornamentation' of a T-shirt can be of a special nature which inherently tells the purchasing public the source of the T-shirt, not the source of manufacture but the secondary source. Thus, the name "New York University" and an illustration of the Hall of Fame, albeit it will serve as ornamentation on a T-shirt will also advise the purchaser that the university is the secondary source of that shirt.") Thus, the fact that there are other universities using the letters "SC" and, in fact, several universities using marks identical to California's Athletic Interlock and Baseball Interlock in connection with educational services and athletic exhibitions is probative concerning the sixth DuPont factor, which examines "the number and nature of similar marks in use on similar goods." In re E. I. Du Pont de Nemours & Co., 476 F.2d 1357, 1361, 177 U.S.P.Q. 563 (C.C.P.A. 1973).

D.¹ Exhibit 14 to the Testimony Deposition of Elizabeth West Taken March 2, 2006

Opposer has objected to Applicant's Exhibit 14 on the basis that this exhibit is not relevant. Exhibit 14 is a June 1854 history exam which shows the use of "SCC" to refer to "S.C. College." This exhibit is relevant because it provides evidence that Applicant used the letters "SC" in self-reference as early as 1854. Furthermore, it demonstrates that the general public, including Applicant's students, were aware that "SC", as a part of "SCC or S.C. College", was

¹ Opposer erroneously used two "D"'s in its brief. For the sake of clarity, Applicant has paralleled Opposer's headings in its Response.

being utilized by Applicant. Therefore, the use of “SC” on this exam is relevant in this case to show Applicant’s use of the letters “SC” in reference to itself since 1854.

E. Exhibit 15 to the Testimony Deposition of Elizabeth West Taken March 2, 2006

Opposer has objected to Applicant’s Exhibit 15 on the basis that this exhibit is not relevant. Exhibit 15 is an invitation issued by the S.C. College Clariosophic and Euphradian Societies for various celebrations and events in the years 1883, 1884, 1885, 1891, and 1897. This exhibit is relevant because it provides evidence that student organized groups authorized by the Applicant used the letters “SC” in self-reference as early as 1883. Furthermore, it demonstrates that the general public, including Applicant’s students, recognized the abbreviation “SC” as a part of “SCC or S.C. College”. Therefore, the use of “SC” on the invitations is relevant in this case to show Applicant’s use of the letters “SC” in reference to itself since 1883 and at various points thereafter.

F. Exhibit 16 to the Testimony Deposition of Elizabeth West Taken March 2, 2006

Opposer has objected to Applicant’s Exhibit 16 on the basis that this exhibit is not relevant. Exhibit 16 is an 1898 photograph of the Applicant’s football team wearing jerseys with the letters “SC” on them. This exhibit is relevant because it provides evidence that the “SC” mark was being used by Applicant’s football team during this early time period (prior to Opposer’s first use of the letters “SC”).

As discussed above, the trademark rights in this case available to California and South Carolina for their clothing products have their roots in each institutions’ educational services and entertainment services in the nature of athletic exhibitions. In re Paramount Pictures Corp., 213 U.S.P.Q. 1111 (T.T.A.B. 1982) (MORK & MINDY was held registrable for decals, because applicant had a television series of that name and had previously registered MORK & MINDY

for various goods and services and the term MORK & MINDY to a prospective purchaser of decals was to indicate the television series and the principal characters of the television series); In re Olin Corp., 181 U.S.P.Q. 182 (T.T.A.B. 1973). Considering the fact that this case focuses primarily on university athletics and fan support thereof, this photograph is extremely relevant to the issue of Applicant's use of the "SC" mark in the context of the athletic competitions and exhibitions. Furthermore, the use of the letters on a football jersey demonstrates that the general public possessed a level of recognition that the letters "SC" comprised a shorthand reference to the Applicant in 1898. Therefore, the use of "SC" on the football jersey is relevant in this case to show Applicant's use of the letters "SC" in reference to itself since 1898 and at various points thereafter. Moreover, the Opposer has relied on the same type of evidence to support its claims of first use. As a result, the Opposer should be estopped from making this argument or should withdraw its Notices of Reliance containing such exhibits.

III. APPLICANT'S RESPONSE TO EVIDENTIARY OBJECTIONS TO EXHIBITS FILED IN CONNECTION WITH APPLICANT'S NOTICE OF RELIANCE

South Carolina hereby responds to California's objections to exhibits attached to applicant's notice of reliance.

A. Exhibits Filed In Conjunction with Applicant's Notice of Reliance No. 1

Opposer has objected to Applicant's Exhibits 88 and 89 attached to Applicant's Notice of Reliance No. 1. These exhibits comprise a newspaper article published in The State on 5/12/98. The article includes a photograph of Applicant's baseball coach Ray Tanner wearing a baseball cap with Applicant's mark. Among other things, this photograph demonstrates the manner in which Applicant's mark is seen by members of the public, specifically including fans of South Carolina and potential purchasers of merchandise. Furthermore, the context in which it is used amply demonstrates that there is no likelihood of confusion between Applicant and Opposer's

marks as Applicant's mark is commonly used in this context (i.e., Ray Tanner and other South Carolina coaches have not been featured in publications wearing a hat bearing Opposer's marks). Finally, despite Opposer's contention, the prominent use of the mark in 1998 and the relative fame of the mark after the date of application, do have a bearing on whether actual confusion exists in the marketplace, which is a crucial issue in this case. Kenner Parker Toys v. Rose Art Indus., 963 F.2d 350, 352, 22 U.S.P.Q.2D 1453 (Fed. Cir. 1992) (T.T.A.B.'s test for likelihood of confusion evaluates objective evidence that the marks, when used in the marketplace, are likely to confuse the purchasing public about the source of the products); McCormick & Co., Inc. v. Marion K. Summers, 53 C.C.P.A. 851, 858, 354 F.2d 668, 148 U.S.P.Q. 272 (C.C.P.A. 1966) ("registrability of a mark must be determined on the basis of facts as they exist at the time when the issue of registrability is under consideration").

B. Exhibits Filed In Conjunction with Applicant's Notice of Reliance No. 2

Opposer has objected to Applicant's Exhibit 90 attached to Applicant's Notice of Reliance No. 2 at 90.5 and 90.7. These exhibits are excerpted from a publication entitled *Remembering the Days: An Illustrated History of the University of South Carolina*. Opposer first objects to the picture of the plaque at 90.5. This is curious since counsel for Opposer moved a depiction of this same plaque into evidence during the West deposition. (See TD-West, 23:5 – 24:25.) Therefore, any of Opposer's objections to 90.5 should be disregarded. Further, as it will be highlighted below, because Applicant is an agency and subdivision of the state of South Carolina, it is entitled to enjoy the benefits of the state's usage of the letters "SC."

Additionally, Opposer's objection to 90.7 is also misplaced. The ring on 90.7 is a class ring which bears the letters "SC" in an interlocking fashion. As the text demonstrates, the ring is kept at the University Archives. This is plainly relevant to Applicant's contention that the letters

“SC” have been used by Applicant and known to the public for centuries. Therefore, this page is relevant and Applicant’s objection should be overruled.

C. Exhibits Filed In Conjunction with Applicant’s Notice of Reliance No. 3

Opposer has objected to Applicant’s Exhibits 91-105 on the grounds of relevance. Some (but not all) of these exhibits demonstrate historical uses of the letters SC by the government of South Carolina.² These exhibits are relevant to the generalized public recognition of the letters “SC” as a shorthand abbreviation and trademark of the State of South Carolina, which is the manner in which Applicant is using “SC” as a discreet mark. The prevalence of the use of “SC” throughout American history therefore demonstrates the relative fame of the “SC” mark in that context and it undercuts any argument that Applicant and Opposer’s “SC” marks will be confused.

Additionally, as an agency of the state of South Carolina, Applicant intends to claim the benefit of the state’s long usage of the letters “SC.” See e.g., Gaylord Bros., Inc. v. Stroebel Products Co., Inc., 140 U.S.P.Q. 72 (T.T.A.B. 1963) (opposition proceeding defeated since predecessor entity related to applicant used mark prior to opposer). The University of South Carolina is an alter ego of the State of South Carolina. See Bartges v. University of North Carolina, 908 F. Supp. 1312, 1332-33 (W.D.N.C. 1995) (finding UNC at Charlotte to be an alter ego of the State of North Carolina and thus immune under the Eleventh Amendment), aff’d, 94 F.3d 641, 1996 WL 460766 (4th Cir.1996); Clemson Univ. v. W.R. Grace & Co., No. 2:86-2055-2, 1991 WL 112319, at *11, *13 (D.S.C. 1991)(holding that Clemson University and the College of Charleston are "alter-egos" of the State of South Carolina); Roberson v. Dale, 464 F. Supp. 680, 689 (M.D.N.C. 1979) (holding that UNC at Chapel Hill, is an "alter-ego" of the

² Applicant assumes that Opposer has no objection to Exhibits 94, 98, 100, 101, 102, 103, and 105 since these are not directly related to, nor were they created by, the state government of South Carolina.

State). As an “alter ego” of the State of South Carolina, the Applicant, the University of South Carolina, may assert priority based upon the state’s use of the letters “SC”.³

Furthermore, disregarding the issues at the heart of Opposer’s objection, at a minimum, each of these exhibits demonstrates use of the “SC” mark (sometimes in interlocking fashion) by parties other than Opposer, and some of these uses predate Opposer’s first use of the mark. Therefore, the use of the “SC” mark by third parties also relates to the relative strength or weakness of Opposer’s mark and these exhibits are therefore relevant on those grounds as well.

D, E. Exhibits Filed In Conjunction with Applicant’s Notices of Reliance Nos. 4 and 5

Opposer has objected to Applicant’s Exhibits 106-134, 142-146, and 148-151 on the grounds of relevance. These exhibits demonstrate the historical uses and recognition of the letters “SC” by Applicant, its students, and the general public. Frankly, these exhibits provide some of the most relevant evidence in the entire proceeding as to whether a likelihood of confusion exists. Among other things, each of the exhibits demonstrates the connection between Applicant and the letters “SC” throughout its long history. Applicant has contended from the outset that it enjoys an equal, if not greater, public association with the letters “SC” than Opposer. As a result, consumers, and especially sports fans, will not confuse the marks. At a minimum, even if Opposer disagrees with the persuasiveness of these exhibits, Opposer must admit that these exhibits are at least relevant to the issues at bar.

Again, these exhibits show the use of “SC” in the context of multiple different university sports, and, as the Board is aware, the use of Applicant and Opposer’s marks on athletic and fan

³ Opposer’s assertion that the July 31st Order stands for the proposition that South Carolina cannot rely upon uses of the letters “SC” by the State of South Carolina is overreaching. To begin, the comment made by the Board is limited to its context which was a claim under Section 2(a) and not 2(d). Furthermore, the case cited by the Board, specifically acknowledges that under 2(d) a party, such as a subsidiary (or in this case a state agency), has standing to maintain a cancellation or opposition proceeding. Jewelers Vigilance Committee, Inc. v. Ullenberg Corp., 823 F.2d 490, 493, 2 U.S.P.Q.2D 2021 (Fed. Cir. 1987) (“Similarly, one of our predecessor courts recognized that a parent corporation has standing to oppose on the basis of a mark owned and controlled by its subsidiary.”)

merchandise and apparel is the crux of this case. As discussed above, these exhibits establish use of the letters “SC” as a service mark for education services and entertainment services in the nature of live exhibition of sporting events. Neither California’s nor South Carolina’s trademark rights are based upon its goodwill or fame as a manufacturer of clothing or headwear. On the contrary, the “SC” used by South Carolina and California on its clothing goods is merely ornamental and would not be registrable but for the letters “SC” serving as a secondary indicator of source. In re Olin Corp., 181 U.S.P.Q. 182, 183 (T.T.A.B. 1973) (It is a matter of common knowledge that T-shirts are "ornamented" with various insignia, including college insignias . . . [such] ‘ornamentation’ of a T-shirt can be of a special nature which inherently tells the purchasing public the source of the T-shirt, not the source of manufacture but the secondary source. Thus, the name "New York University" and an illustration of the Hall of Fame, albeit it will serve as ornamentation on a T-shirt will also advise the purchaser that the university is the secondary source of that shirt.”)

South Carolina’s use of the mark in connection with its education services and athletic teams are relevant and proper evidence of service mark usage. The June 1854 Test (A-Ex. 106), the 1901 Yearbook showing use of the letters “SCC” (A-Ex. 114), and the 1904 Yearbook with SC pennant (A-Ex. 121) are relevant evidence showing that the letters “SC” or “SCC” were used by South Carolina in connection with educational services. The other photographs and drawings are all related to the use of the letters “SC” on uniforms (A-Ex. 107, 108, 110, 112, 115, 116, 117, 118, 119, 120, 122, 125, 126, 143, 145, and 146.) Use of the letters “SC” on uniforms that are viewed by the public is evidence of service mark use by South Carolina. South Carolina would also assert that it is evidence of trademark use. This evidence is relevant to show that the letters “SC” are a secondary indicator of source of the University of South Carolina. (See TMEP

§ 1203.03(c)) (concerning evidence of “non-ornamental use of the mark in commerce on other goods or services”).)

Opposer’s objection to 148-151 is spurious. It is based solely upon California’s claim that such evidence establish only de minimis use. This objection goes solely to the weight and character of the evidence and is an improper objection. In fact, California’s argument that these are minor sports only highlights the extensive use of the letters “SC” by South Carolina. As discussed above, South Carolina has established that this type of evidence is relevant.

F. Exhibits Filed In Conjunction with Applicant’s Notices of Reliance No. 6

Opposer has objected to Applicant’s Exhibits 158-164 on the grounds of relevance. These exhibits are Applicant’s baseball media guides and they demonstrate the use of Applicant’s applied-for mark by the baseball team during the years 1998 – 2004. Opposer’s objection to these materials is fallacious for several reasons. Opposer incorrectly claims that “the exhibits do not show the nature of South Carolina’s goods. . .” (See Opposer’s Objections, p. 23.) This is not true. The baseball caps and jerseys as depicted in the media guides are the same items of apparel offered for purchase to consumers. This is demonstrated by multiple other exhibits which show vendors who offer the caps for sale. Moreover, by prominently displaying the apparel on South Carolina’s players and coaches, the media guides act as a *de facto* advertisement of South Carolina’s apparel which contains Applicant’s marks. Therefore, these exhibits clearly show the nature of South Carolina’s goods.

Additionally, despite Opposer’s repeated arguments to the contrary, the Baseball Media Guides, including the pictures of manner of use of goods bearing the Applicant’s marks, demonstrate the absence of any likelihood of confusion between Applicant and Opposer’s marks.

As it will be shown below, evidence of Applicant's use of the marks after the application date is entirely relevant in this case.

The Baseball Media Guides also establish significant use of the South Carolina Baseball Logo in connection with entertainment services; namely the exhibition of collegiate baseball games. Therefore, the Baseball Media Guides are similarly relevant to the issue of serving as a secondary indicator of source.

G. Exhibits Filed in Conjunction with Applicant's Notice of Reliance No. 7

Opposer has objected to Applicant's Exhibits 165-168 on the grounds of relevance. California has entered into two consent agreements reflecting that the market interface between California and South Carolina's consumers is such that confusion is unlikely. Furthermore, California has entered into another consent agreement with Spelman College reflecting that other higher education institutions can use stylized version of the letters "SC" without a likelihood of confusion. Exhibits 165-168 consist of the agreements and orders relating to the concurrent use of Applicant and Opposer's marks as well as a consent agreement between Opposer and Spelman College. These documents relate directly to Applicant's arguments concerning the market interface, waiver and other equitable issues establishing that California truly does not believe that there is a likelihood of confusion between any use of the mark "SC" by California and the South Carolina Baseball Logo. Specifically, Applicant contends that Opposer's "sitting" on its trademark rights, as demonstrated by the exhibits, constitutes a waiver of its claims against Applicant. Furthermore, Opposer's willingness to wait for years to file its opposition demonstrates the merit of Applicant's position that no confusion has ever existed between the marks of the parties. Certainly, any contention that Opposer was suffering widespread problems

with Applicant's continued and concurrent use of the "SC" mark is undercut by Opposer's decision to wait to file the opposition in this case.

On August 10, 1981, California and South Carolina entered into an agreement (the "1981 Consent Agreement") regarding each institution's use of the mark "USC". (A-Ex. 167.) California objects to the 1981 Consent Agreement on the grounds that it is a different mark. However, the difference between USC and SC is minute – consisting of only a "U" common to both marks. The 1981 Consent Agreement does not limit itself to any particular design or stylization of the letters "USC." (Id.) In the 1981 Consent Agreement, the parties represent that "the designation USC by Southern California and South Carolina has not resulted, to the knowledge of either party, in a single instance of actual confusion." (A-Ex. 167.2.) As a result, California agrees that it "shall not object and hereby consents to the use by South Carolina or its licensees, distributors or other lawful designees of the designation USC on and in connection with educational and related services as well as consumer products of varying description." (Id.) By entering this agreement, California has indicated that the market interface is such that confusion is unlikely. As a result, this Exhibit and testimony concerning this Exhibit is relevant.

On October 1, 1997, California and South Carolina entered into another Consent Agreement (the "1997 Consent Agreement") regarding registration and use of the mark "USC" in connection with each school's services. (Stip. Fact ¶ 60; A-Ex. 166.) The October 1, 1997 Agreement was a settlement of the Concurrent Use Proceeding No.1089. (Stip. Fact ¶ 61; A-Ex. 165, p. 3.) The 1997 Consent Agreement and Board's Order approving the Agreement are Exhibits 165 and 166. The 1997 Consent Agreement also concerns the letters "USC" in any stylization and, in fact, resulted in standard character concurrent use registrations. The 1997 Consent Agreement also recites that neither party is aware of any actual confusion resulting from

their concurrent use of the letters USC within their respective territories. (A-Ex. 165, p. 2) By entering this agreement more than a decade and a half later, California has again clearly indicated that the market interface between California educational services and South Carolina's educational services is such that confusion is not likely. Furthermore, to the extent that California may argue that such services are radically different from its collegiate-branded products, South Carolina would again assert that, since the letters "SC" are registrable by virtue of serving as a secondary indicator of source, the fact that there is no likelihood of confusion with the primary indicator of source is extremely relevant to this matter.

Finally, in February 1993, the University of Southern California entered into an Agreement with Spelman College (the "Spelman Consent Agreement"). (A-Ex. 168.) The Spelman Consent Agreement is Exhibit 168. In the Spelman Consent Agreement, California agreed not to oppose any of Spelman College's trademark applications, serial nos. 74/338,417, 74/338,407, 74/338,414 and 74/338,579 to register the letters "SC". (A-Ex. 168, p. 3, para. 2).

California also agreed that if any of Spelman College's trademark applications, serial nos. 74/338,417, 74/338,407, 74/338,414 and 74/338,579 to register "SC", were refused on the grounds of confusing similarity to the registration resulting from 74/338,579, then California would sign a statement for Spelman College to file with the Patent and Trademark Office saying that in the University of Southern California's opinion there is no confusing similarity between the two marks. (A-Ex. 168, p. 4, para. 5.)

California acknowledged and agreed that "the University of Southern California's "SC" mark and Spellman College's "SC (and schoolhouse design)" mark do not currently conflict, and have not resulted in any actual confusion or likelihood of confusion in the past. Neither party foresees development of any such confusion or likelihood of confusion so long as neither party is

in violation of this agreement.” (A-Ex. 168, pp. 4-5, para.7.) It is important to note that there are no further restrictions on use of the marks, limitations of channels of trade, geographic restrictions. Lastly, California agreed that it would not challenge or “try to impede Spelman or its licensees from using Spelman’s “SC (and schoolhouse design)” logo on typical college bookstore merchandise.” (A-Ex. 168, p. 4.) California’s primary argument concerning the Spelman Consent Agreement concerns dishonest characterizations of its substance, such as the design of Spelman College’s mark. These arguments are fit for trial, but not in objections to said evidence. California cannot escape the fact that its agreement with Spelman College suggests that Opposer is seeking to “pick and choose” who can use the “SC” mark, and such conduct undermines Opposer’s current posture in this case. See e.g. Swedish Beer Export Co., 469 F.2d 1096, 176 U.S.P.Q. 59 (C.C.P.A. 1972). The Spelman College Agreement is likewise relevant. See e.g. California Fruit Growers Exch. v. Sunkist Baking Co., 166 F.2d 971, 975, 76 U.S.P.Q. 85 (7th Cir. 1947).

H. Exhibits Filed in Conjunction with Applicant’s Notice of Reliance No. 9

Opposer has objected to Applicant’s Exhibits 170-171 on the grounds of relevance. These exhibits consist of printouts from South Carolina’s website and the CNNSI website which show versions of the “SC” baseball mark. Opposer argues that any evidence as to fame or public use after the application filing date of September 16, 1997 cannot be considered. This position is fallacious for two reasons.

First, this position assumes that California is the senior user of the mark. It is not and South Carolina has clearly made this an issue in this case. South Carolina has established that it is senior in priority with the better quality evidence in the form of an original 1898 photograph of the South Carolina Football team showing at least five members of the football team wear

uniforms containing an interlocking “SC”. (A-Ex. 16; TD-West 12:20-13:4.) As further proof of its date and authenticity, this photograph was reproduced and appeared in the 1898 Garnet and Black Yearbook. (A-Ex. 16; TD-West 12:20-13:4.) There is no proof in the record that the letters “SC” were ever used by California on products or on uniforms, as a service mark, until some time around 1906. California’s assertion for this date is based upon an undated photograph of the football team with one member holding a ball upon which it is written “Coast 06 Champions”. (O-Ex. 81.1.) However, it is also important to note that the word mark application for “SC” does not allege use in commerce until 1926. (A-Ex. 169.)

Secondly, as courts have noted, “[t]rademark rights are not static.” In re Thunderbird Products Corp., 56 C.C.P.A. 969, 160 U.S.P.Q. 730 (C.C.P.A. 1969) (board held to have properly considered literary references suggesting descriptiveness after date of application) citing McCormick & Co., 354 F.2d 668.

It is well established that evidence regarding the likelihood of confusion which arises after the application date may be considered as relevant. R. J. Reynolds Tobacco Co. v. American Brands, Inc., 493 F.2d 1235, 1237, 181 U.S.P.Q. 459 (C.C.P.A. 1974) (“This court has, in fact, considered evidence bearing on the issue of likelihood of confusion covering a period subsequent to the date of the application for registration in a number of cases.”); Industria Espanola De Perlas Imitacion v. National Silver Co., 59 C.C.P.A. 1058, 459 F.2d 1049, 173 U.S.P.Q. 796 (1972) (in reaching its decision that there was a likelihood of confusion, court considered evidence of sales and advertising well after date of application); Myrurgia, S.A. v. Comptoir De La Parfumerie, S. A. Ancienne Maison Tschanz, 58 C.C.P.A. 1167, 441 F.2d 673, 169 U.S.P.Q. 587 (1971) (in an opposition proceeding against an application for registration filed

July 28, 1964, the court considered opposer's advertising expenditures and sales for the period 1964 through September 30, 1966.) Therefore, this objection should be overruled.

I. Exhibits Filed in Conjunction with Applicant's Notice of Reliance No. 13

In its objections to Applicant's Exhibit 213, Opposer essentially incorporates its prior objections relating to historical use of the letters "SC" by the state of South Carolina. Therefore, Applicant would incorporate herein by reference its responses to those objections.

J. Exhibits Filed in Conjunction with Applicant's Notice of Reliance No. 14

Opposer has objected to Applicant's Exhibit 215 on the grounds of relevance. This exhibit is a picture of a child's baseball jersey which contains the "SC" baseball mark. As Opposer knows, South Carolina is an educational institution which does not field children's baseball teams. Therefore, as should be evident, this jersey is a piece of merchandise which bears Applicant's mark.⁴ Therefore, it is relevant to the manner in which Applicant's marks are viewed and sold in commerce. Applicant has already addressed arguments relating to evidence after the date of application, and such evidence is entirely relevant here.

K, L. Exhibits Filed in Conjunction with Applicant's Notices of Reliance No. 16 and 18

Opposer has objected to Applicant's Exhibits 217-358 on the grounds of relevance. Exhibits 217-357 show the use of similar and/or identical marks by literally dozens of universities around the country. Exhibit 358 is a list of universities. To begin, despite California's assumptions, South Carolina is not asserting these registrations to argue that California's use of the letters "SC" is weak or diluted.

Evidence of widespread third-party use, in a particular field, of marks containing a certain shared term is competent to suggest that purchasers have been conditioned to look to the

⁴ One would assume that, had Applicant offered testimony on this exhibit, Opposer would have offered yet another "document speaks for itself" objection.

other elements of the marks as a means of distinguishing the source of goods or services in the field. In re: Broadway Chicken, Inc., 38 U.S.P.Q.2d 1559, 1565-66 (T.T.A.B. 1996). See also TMEP § 1207.01 (d)(i)(iii): “Third-party registrations may be relevant to show that the mark or a portion of the mark is descriptive, suggestive, *or so commonly used* that the public will look to other elements to distinguish the source of the goods or services. (See, e.g., Plus Products v. Star-Kist Foods, Inc., 220 U.S.P.Q. 541, 544 (T.T.A.B. 1983).) Properly used in this limited manner, third-party registrations are similar to dictionaries showing how language is generally used. (See, e.g., Specialty Brands, Inc. v. Coffee Bean Distributors, Inc., 748 F.2d 669, 675, 223 U.S.P.Q. 1281, 1285-86 (Fed. Cir. 1984).) In this case, the list of four year institutions and the third-party registrations have been offered to establish that (a) there are over 2,700 four year colleges or universities in the United States (A-Ex. 373) (b) it is common for universities to use their initials, such as A for the University of Arkansas (and thus, they are descriptive), (c) it is also common for universities to drop the “U” for university and adopt the initial representing the state or geographic area related to the school, such as M for the University of Michigan and (d) since there are only 26 letters in the alphabet it is very common that there will be multiple colleges and universities that possess the same initials. As a result, as discussed by several of South Carolina’s witnesses, consumers of collegiate products look beyond the common elements (i.e., the common initials) to other elements to distinguish the marks.

Interestingly, one of Opposer’s primary arguments here is that “the existence of confusingly similar marks on the register (assuming that is the case) cannot aid an applicant to register another confusingly similar mark.” (Opposer’s objections, p. 28.) At a minimum, this statement infers that the U.S. Patent and Trademark Office should not have issued registrations for multiple universities whose marks share letters with other universities. Obviously, the

converse of this is where the actual truth lies. Specifically, all of the registrations issued because the examiners recognized the reality that there is no likelihood of confusion over marks from different and distinct universities. In any event, at a minimum, the proffered evidence is relevant to Applicant's arguments relating to the lack of confusion which exists in the field of university licensing and marketing and Opposer's objections to this evidence should therefore be overruled.⁵

M. Exhibits Filed in Conjunction with Applicant's Notice of Reliance No. 19

Opposer has objected to Applicant's Exhibits 374-380 on the grounds of relevance. These exhibits are printouts from various apparel and merchandise websites which sell goods bearing Applicant's mark. There is no discernable basis for Opposer's objection to these exhibits. Opposer objects to these exhibits on the muddled basis that "[w]hile Applicant contends that Applicant's Exs. 374-380 demonstrate that there are no instances of actual confusion, Applicant's evidence only shows that some of the websites have been corrected." (Opposer's objections, p.31.) Frankly, this is neither a valid (nor easily identifiable) basis for exclusion. Both parties have submitted website printouts on the issue of likelihood of confusion and, in this instance, the website printouts demonstrate that there was no commingling of Applicant's and Opposer's goods by these merchants at the time they were printed out. This supports Applicant's position that there is no likelihood of confusion as the goods are sold, these exhibits are relevant and should not be excluded.

⁵ Additionally, Opposer's attempted comparison of university marks with those of hotel chains is baseless. Unlike the example fabricated by Opposer, each university's mark in the exhibits is comprised of a few letters. Therefore, the similarities between the parallel universities' marks and the "SC" marks involved in this proceeding is undeniable.

O.⁶ Exhibits Filed in Conjunction with Applicant's Notice of Reliance No. 20

Opposer has objected to Applicant's Exhibits 381-382 on the grounds of relevance. These exhibits are baseball and softball posters from the 2005 season which display the manner in which the "SC" baseball mark is used on uniforms. Once again, Opposer erroneously claims that, because these posters were made after the application date, they cannot be considered. This is patently false. Additionally, evidence of the manner in which the "SC" mark is used (and how it is publicly displayed in materials by the university) is relevant to the overall fame of the mark as well as a determination as to the likelihood of confusion. Therefore, Opposer's objection should be overruled.

P. Exhibits Filed in Conjunction with Applicant's Notice of Reliance No. 24

Opposer has objected to Applicant's Exhibit 402 on the grounds of relevance. This exhibit demonstrates that California has played Santa Clara (another user of an "SC" mark). Such evidence is relevant because Opposer did not contest for years and has not now contested Santa Clara's use of the "SC" mark, and, based on geographic location, there is clearly a higher potential of overlap and contact between California and Santa Clara as opposed to California and South Carolina. Therefore, this evidence is relevant and Opposer's objection should be overruled.

Q. Exhibits Filed in Conjunction with Applicant's Notice of Reliance No. 28

Opposer has objected to Applicant's Exhibits 444-458 on the grounds of relevance. These exhibits contain depictions of uses of "SC" by Applicant throughout its history. Again, how these exhibits would be irrelevant is absolutely beyond comprehension. The fact that these marks undermine Opposer's case is not grounds for their exclusion.

⁶ Opposer neglected to include a section "N" in its brief.

Again, these exhibits show the use of “SC” in the context of multiple different university sports, and, as the Board is aware, the use of Applicant and Opposer’s marks on athletic and fan merchandise and apparel is the crux of this case. As discussed above, these exhibits establish use of the letters “SC” as a service mark for education services and entertainment services in the nature of live exhibition of sporting events. This is important because South Carolina’s and California’s use of the letters “SC” on clothing is merely ornamental and would not be registrable but for the letters “SC” serving as a secondary indicator of source. In re Olin Corp., 181 U.S.P.Q. 182, 183 (T.T.A.B. 1973).

South Carolina’s use of the mark in connection with its education services and athletic teams are relevant and proper evidence of service mark and trademark usage. The 1935 drawing of the stadium is relevant to show that in 1935 South Carolina was referring to itself as SC and that fans would be familiar with these letters (A-Ex. 446.) The 1938 Garnet & Black yearbook cover showing use of the letters “SC” establishes that it was common for South Carolina to shorten the words “South Carolina” to the initials “SC”. (A-Ex. 448) The 1940 yearbook showing the letters “SC” on the cover and a sign bearing the letters “SC” is likewise relevant to demonstrate use of the letters “SC”. (A-Ex. 450).

The following exhibits are photographs establishing use of the letters “SC” on various athletic uniforms (A-Ex. 444, 445, 446, 447, 449, 451, 452, 453 and 456.) Use of the letters “SC” on uniforms that are viewed by the public is evidence, at least of service mark use by South Carolina. South Carolina would also assert that it is evidence of trademark use. This evidence is relevant to show that the letters “SC” are a secondary indicator of source of the University of South Carolina. (See TMEP § 1203.03(c)) (concerning evidence of “non-ornamental use of the mark in commerce on other goods or services”).)

Applicant's Exhibits 454, 457 and 458 contains photographs of students or fans wearing shirt or hats bearing the letters "SC". This is relevant to show that products bearing the letters "SC" were in existence during this time period. Opposer's speculation concerning the source is just that. It is not grounds to exclude this evidence as being irrelevant.

Applicant's Exhibit 455 shows a picture of the historical marker on campus bearing the letters "SC". This historical marker discusses the history of the University of South Carolina. As such, it is evidence that the letters "SC" were used in connection with signage by the State of South Carolina and its agency, the University of South Carolina.

Moreover, Opposer's objection that such evidence establishes only *de minimis* use is spurious. This objection goes solely to the weight and character of the evidence and is an improper objection. In fact, California's argument that these are minor sports only highlights the extensive use of the letters "SC" by South Carolina. As discussed above, South Carolina has established that this type of evidence is relevant.

IV. APPLICANT'S RESPONSE TO OPPOSER'S EVIDENTIARY OBJECTIONS TO THE PARTIES' STIPULATIONS OF FACT

Applicant the University of South Carolina ("Applicant" or "South Carolina") hereby responds to Opposer the University of Southern California's ("Opposer" or "California") objections to the parties' Stipulations of Fact filed with the Board on December 29, 2005.

- Stip No. 84. South Carolina's resident undergraduate tuition is \$6,914 (per academic year)
- Stip No. 85. South Carolina's non-resident undergraduate tuition is \$18,556 (per academic year)
- Stip No. 86. The name of South Carolina's mascot is Cocky.
- Stip. No. 88. South Carolina's athletic conference is the Southeastern Conference.

- Stip. No. 91. California's undergraduate tuition and mandatory fees (2205-06 academic year) are \$32,008.
- Stip. No. 92. California's team name is the Trojans.
- Stip. No. 93. California's mascots are Tommy Trojan and Traveler.
- Stip. No. 95. California is in the PAC-10 Athletic Conference.

Opposer claims that the foregoing facts are not relevant to the present case. On the contrary, these facts are relevant to the depth of difference between Applicant and Opposer. These facts were submitted in support of Applicant's arguments regarding the distinctions between Applicant and Opposer which undermine the notion that relevant consumers would confuse the two institutions. Therefore, these facts are relevant and they should be considered.

- Stip. No. 96. On September 17, 1992, Spelman College filed a request for an extension of time to oppose Serial No. 74/094,681.
- Stip. No. 97. On October 16, 1992 Spelman College filed a second request for an extension of time to oppose Serial No. 74/094,681 because settlement negotiations were taking place.
- Stip. No. 98. On December 16, 1992, Spelman College filed a third request for an extension of time to oppose Serial No. 74/094,681 because a written settlement proposal had been made by Spelman College and negotiations were ongoing.
- Stip. No. 99. On January 15, 1993, Spelman College filed a fourth request for an extension of time to oppose Serial No. 74/094,681 because a written settlement proposal had been made by Spelman College and negotiations were still ongoing.

Each of the foregoing facts supports Applicant's arguments that (1) no likelihood of confusion exists between Opposer and other educational institutions which utilize an "SC" mark and (2) that Opposer has simply chosen those against whom it will seek to enforce its trademark rights. (See e.g., FS Services, Inc. v. Custom Farm Services, Inc., 325 F. Supp. 153, 158, 168 U.S.P.Q. 503 (N.D. Ill. 1970)) ("The manner in which [uses of plaintiff's mark by third-parties] have been handled by plaintiff and the extent to which these other uses have or have not

produced evidence of confusion are pertinent to the credibility of plaintiff's claim here that there is a likelihood of confusion between plaintiff's and defendant's trademarks.”)

- Stip. No. 101. The letters “SC” are used as a part of the official state web address www.state.sc.us, which links to the official state website, www.mySCgov.com.
- Stip. No. 102. Various state agencies have adopted the letters “SC” as a part of their agency acronyms, such as SCDHEC or SCDOR.
- Stip. No. 103. The South Carolina Air National Guard has used “SC” on aircraft for decades.
- Stip. No. 104. Since at least 1936, the letters “SC” have been used by the South Carolina Historical Marker Program on official markers around the state of South Carolina.
- Stip. No. 105. The letters “SC” are commonly used on maps as the geographical abbreviation for the state of South Carolina.
- Stip. No. 106. Since at least as early as the Revolutionary War, the South Carolina militia and State military have used the letters “SC” on clothing, uniforms, and equipment.
- Stip. No. 107. The letters “SC” are the official State Abbreviation assigned to the State of South Carolina by the United States Postal Service. Source: http://www.usps.com/ncse/abbr_state.txt.

Opposer claims that the foregoing facts are not relevant to the present case. However, as earlier stated in this Response, Applicant is a subsidiary and subdivision of the State of South Carolina which has used the “SC” mark for centuries, as these facts demonstrate. Therefore, these facts are relevant to Applicant's rights to the letters “SC” derived from uses by the state.

Additionally, even if the arguments relating to Applicant's status as a subsidiary of the State are disregarded, each of the foregoing facts suggests use of the “SC” mark by third parties for centuries, which undercuts Opposer's rights in the mark.

[SIGNATURE ON NEXT PAGE]

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October 9, 2006

CERTIFICATE OF SERVICE

The undersigned of the law offices of Nelson Mullins Riley & Scarborough, L.L.P., attorneys for Applicant do hereby certify that I have served all counsel in this action with a copy of the pleading(s) hereinbelow specified by e-mailing a copy of same and by mailing a copy of the same by United States Postal Service First Class Mail, with proper postage thereon, to the following address(es):

Pleadings: RESPONSE TO OPPOSER'S SEPARATE STATEMENT OF
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